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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/592,985	09/12/2007	Xiaodong Wang	019941-011010US	7333
20350 7590 06/01/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER CHANDRAKUMAR, NIZAL S				
ART UNIT 1625		PAPER NUMBER		
MAIL DATE 06/01/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/592,985

**Applicant(s)**

WANG ET AL.

**Examiner**

NIZAL S. CHANDRAKUMAR

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

This application is a 371 of PCT/US05/12837 04/13/2005  
which claims benefit of 60/562,035 04/13/2004

Claims 1-37 are before the Examiner and subject to the following:

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-24, 32, 33-37, drawn to compounds of core structure of formula III (as found in claim 35).

Group 2, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A and B are five-membered heteroaryl and X is a bond. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 3, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A is a five-membered heteroaryl and X is a bond and B is 6-membered heteroaryl other than

compounds of Group 1. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 4, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A and B are six-membered heteroaryl and X is a bond. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 5, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A is a six-membered heteroaryl and X is a bond and B is 5-membered heteroaryl. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 6, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A and B are five-membered heterocyclyl and X is a bond. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 7, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A is a five-membered heterocyclyl and X is a bond and B is 6-membered heteroaryl. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 8, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A and B are six-membered heterocyclyl and X is a bond. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 9, claim(s) 1-24, 32, 33-37, drawn to compounds wherein A is a six-membered heterocyclyl and X is a bond and B is 5-membered heteroaryl. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 10-18, claim(s) 27-28 and 32, drawn to metal complex of chelators corresponding to compounds of Group 1-9. Thus, for example Group 11 would correspond to metal complexes of compounds of Group 2. Election of this group would necessitate further restriction based on the heterocycle/heteroaryl group.

Group 19-36, claim(s) 27-28, drawn to method of decreasing potassium ion flow through potassium channel in a cell. Thus Group 19 corresponds to a method of decreasing potassium ion flow through potassium channel in a cell.

Group 37-71, claim(s) 27-28, drawn to method of decreasing ions other than potassium ions flow through potassium channel in a cell. Identification of ions other than potassium is required to facilitate prosecution.

Group 72-89, claim(s) 29-31, drawn to pharmaceutical method of compounds or complexes of Group 1-18.

The inventions listed as Groups 1-89 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature (the invariant) in all the groups is 1-89 is the 2-aminopyridine structural core. This is not a contribution over prior art as it is a well known structural moiety; see applicant provided (NPL) document XP-002354816, filed 05/18/2008.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nizal S Chandrakumar/



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